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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,606

Applicant(s)

SATO, SHO

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/01/03;10/14/03;01/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 4 & 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/14/03;1/26/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements filed on 10/14/03 & 01/26/04 have been considered and scanned into the application file.

Claim Objections

3. Claims 4 & 5 are objected to because of the following informalities: In claims 4 & 5, @ line 1, it is suggested that the definite article "the" be inserted after "wherein" so as to engender claim language clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamasaki et al (U.S. 5,109,068, equivalent to EP 356,068).

Yamasaki et al teach a styrene-based polymer composition, suitable for materials such as the exterior trim parts of an automobile, engine compartment parts, machine parts, electric and electronic parts, domestic kitchenware, etc. which comprises (A) 10 to 98% by weight of a styrene-based polymer having syndiotactic configuration with a racemic pentad of 30% or more, (B) 90 to 2% by weight of polyphenylene ether such as poly(2,6-dimethyl-1,4-phenylene)ether having an intrinsic viscosity of 0.28 dl/g or more at 30 degree C in chloroform, (C) 3-40 parts by weight, based on 100 parts by weight of components (A) and (B) of a flame retarder which includes phosphorous-based flame retarders such as tricresyl phosphate, triethyl phosphate, etc., (D) 1 to 15 parts by weight, based on 100 parts by weight of components (A) and (B) of a flame-retardant aid, (E) 5 to 85 parts by weight, based on 100 parts by weight of components (A) and (B) of a rubber-like elastomer and/or inorganic filler wherein the rubber-like elastomer includes a partially or fully hydrogenated styrene-butadiene block copolymer, a partially or fully hydrogenated styrene-isoprene block copolymer, etc. and other conventional additives such as antioxidants, lubricants, etc. See the Abstract, col. 1, lines 8-16, col. 2, lines 20-68, col. 3, lines 46-68, col. 4, lines 1-65 and especially lines 4-5 & 62-65, col. 5, lines 1-68, col. 6, lines 18-68, col. 7, lines 62-65, and TABLES 3 and 4 of Yamasaki et al. Yamasaki et al therefore anticipate the instantly claimed invention with the understanding that the resin composition of Yamasaki et al overlaps in scope with the resin composition of the instant claims. The use of the resin composition of Yamasaki et al as a wire and cable covering would be expected since the resin composition of Yamasaki et al is essentially the same as and made in essentially the same manner as the claimed resin composition. It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicants to prove that the prior art product does not inherently or necessarily possess the

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characteristics attributed to the claimed product. See *In re Spada* 15 USPQ 2d 1655 (CAFC 1990). "The absence of a disclosure relating to function does not defeat a finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product". *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431(Fed Cir 1997).

Even if it turns out that the claims are not anticipated by Yamasaki et al, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Yamasaki et al, the defined resin composition, as claimed, as per such having been within the purview of the general disclosure of Yamasaki et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamasaki et al(U.S. 5,109,068), alone, or further in combination with Cizek(U.S. 3,383,435).

Yamasaki et al is relied on for all that it teaches as set forth in the rejection supra per paragraph no. 6 as applied to claims 1-7. Further, the myriad of suitable uses for the resin composition cited per col. 1, lines 8-16 which include machine parts, electric and electronic parts is generic to and necessary implies that any use for the disclosed resin composition, including the claimed "wire covering"(claim 6) and "cable covering"(claim 7), would have been operable within the scope of patentees invention and with a reasonable expectation of success. Alternatively, Cizek teaches the use of thermoplastic compositions comprising a polyphenylene ether and a styrene resin, similar to the resin composition of Yamasaki et al, to prepare molded, calendared or extruded articles, films, tapes, etc. to be used in a broad array of applications such as in electrical applications such as in cable terminals, wire tapes, etc. (see, the paragraph bridging cols 8-9 of Cizek). Therefore, it would have been obvious to one having ordinary skill in the art to use the resin composition of Yamasaki et al for wire coverings and cable coverings as taught by Cizek and with a reasonable expectation of success.

Claim Rejections - 35 USC § 102

10. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Funayama et al(U.S. 5,391,611).

Funayama et al teach a styrenic resin composition, suitable for general construction materials, electric and electronic parts, car parts, raw materials for film, fiber, sheet, etc., comprising (A) a styrenic polymer having high degree of syndiotactic configuration and (B) a rubbery polymer having a product of weight-average molecular weight and styrenic monomer unit content being at least 30,000. More specifically, Funayama et al teach a styrenic resin composition comprising 50 to 98% by weight of (A) a styrenic

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polymer having high degree of syndiotactic configuration and 50 to 2% by weight of (B) a rubbery polymer having a product of weight-average molecular weight and styrenic monomer unit content of at least 30,000 wherein, said rubbery polymer includes styrene-butadiene block copolymer rubber; a styrenic resin composition which comprises 100 parts by weight of the mixture of 50 to 98% by weight of the aforesaid component (A) and 50 to 2% by weight of the aforesaid component (B), 0.1 to 50 parts by weight of (C) a polyphenylene ether having a polar group wherein said polyphenylene ether includes those governed by an intrinsic viscosity of 0.45 in chloroform at 25 degrees C and includes poly(2,6-dimethyl-1,4-phenylene ether(See at least preparation Runs 2 and 3)and 1 to 350 parts by weight of (D) a filler surface-treated with a coupling agent and a styrenic resin composition which comprises 100 parts by weight of the mixture of 50 to 98 % by weight of the aforesaid component (A) and 50 to 2 % by weight of the aforesaid component (B), 0.1 to 50 parts by weight of the aforesaid component (C), 1 to 350 parts by weight of the aforesaid component (D), 3 to 60 parts by weight of (E) a flame retardant which includes tricresyl phosphate, triethyl phosphate, etc., 1 to 15 parts by weight of (F) a flame retardant aid and other conventional additives such as stabilizers, antioxidants, lubricants, other thermoplastic resins such as unmodified polyphenylene ether etc. See the Abstract, col. 2, lines 9-41, col. 3, lines 25-68 to col. 4, lines 1-3, col. 4, lines 56-65, col. 6, lines 43-68, col. 8, lines 30-50, col. 9, lines 6-9 and 15-57, col. 12, lines 22-39 & 57-60, the Runs and the claims of Funayama et al. Funayama et al therefore anticipate the instantly claimed invention with the understanding that the styrenic resin composition of Funayama et al overlaps in scope with the instantly claimed resin composition. The use of the resin composition of Funayama et al et al as a wire and cable covering would be expected since the resin composition of Funayama et al is essentially the same as and made in essentially the same manner as the claimed resin composition. It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicants to prove that

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the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product. See *In re Spada* 15 USPQ 2d 1655 (CAFC 1990). "The absence of a disclosure relating to function does not defeat a finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product". *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed Cir 1997).

Even if it turns out that the claims are not anticipated by Funayama et al, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Funayama et al, the defined resin composition, as claimed, as per such having been within the purview of the general disclosure of Funayama et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

11. Claims 6 & 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funayama et al (U.S. 5,391,611), alone, or further in combination with Cizek (U.S. 3,383,435).

Funayama et al is relied on for all that it teaches as set forth in the rejection supra as applied to claims 1-7. Further, the myriad of suitable uses for the resin composition cited per col. 12, lines 57-60 which includes general construction materials, electric and electronic parts, etc. is generic to and necessary implies that any use for the disclosed resin composition, including the claimed "wire covering" (claim 6) and "cable covering" (claim 7), would have been operable within the scope of patentees invention and with a reasonable expectation of success. Alternatively, Cizek teaches the use of thermoplastic compositions comprising a polyphenylene ether and a styrene resin, similar to the resin composition of Funayama et al, to prepare molded, calendared or extruded articles, films, tapes, etc. to be used in a broad array of applications such as in electrical applications such as in cable terminals, wire tapes, etc. (see, the paragraph bridging cols 8-9 of Cizek). Therefore, it would have been obvious to one having ordinary skill in the art to use the resin composition of Funayama et al for wire coverings and cable coverings as taught by Cizek and with a reasonable expectation of success.

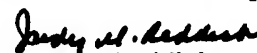
Conclusion


12. The prior art to Nakano et al(U.S. 5,034,441), Nakano(U.S. 5,165,990) and Nakano(U.S. 5,777,021), listed on the attached FORM PTO 892, is cited as of interest in teaching resin compositions comprising a styrene polymer and a polyphenylene ether and considered merely cumulative to the prior art supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
03/21/04